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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,956	12/10/2001	David A. Tirrell	CIT1530-1	2956

7590

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EXAMINER

ROOKE, AGNES BEATA

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,956

Applicant(s)

TIRRELL, DAVID A.

Examiner

Agnes B. Rooke

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-11,14-18 and 56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-11,14-18 and 56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>01/21/2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's election with traverse of Group I, Claims 1-18 and 56 in the reply filed on 01/21/2005 is acknowledged. The traversal is on the ground(s) that examiner has not established an alternative use for the fusion protein by stating that the fusion protein could be used as a therapeutic agent, and that the fusion protein is a subcombination or necessary element of the microarray. Examiner respectfully disagrees because the fusion protein can be used in different biochemical methods, and not necessary in microarray. Also, microarray system can be used for different proteins or fusion proteins, and not necessary the one disclosed in claims 1-18 and 56.

The amendments to the claims have been acknowledged.

Therefore, the restriction requirement is deemed proper and is made

FINAL.

Claims 19-55 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims 8, 12, and 13 are cancelled.

1-7, 9-11, 14-18, and 56 are currently under examination.

A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP paragraph 821.01.

This application claims priority to 60/254,516, filed on 12/08/2000.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-7, 9-11, 14-18, and 56 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

After examination of the SEQ ID NO:1 and SEQ ID NO:2 disclosed in the specification and submitted in the raw sequence listing, the structural formula provided in Claim 1 is indefinite, because the additional parentheses defining the boundary for the "n" values are necessary. For example, the "n" value should refer only to -(Pro-Glu-Gly)- in SEQ ID NO:1, and in SEQ ID NO:2 the "n" value should refer only to -(Glu-Gly)-according to the sequences in the raw sequences listing. Otherwise, the structures provided in Claim 1 do not correlate with the SEQ ID NO:1 and SEQ ID NO:2.

Also, in Claims 1-7 the value of "x" and "n" is not defined.

In Claims 1-3, the phrase *terminal region* is indefinite, and the more appropriate term would be "*terminal residue*."

Claims 6 and 7 lack antecedent basis because aspartic acid is not present in the sequences provided in Claim 1.

Also, Claim 7 fails to further limit Claim 4.

Claims 2-5, 9-11, 14-18, and 56 are included in this rejection because they depend from rejected independent claim and do not correct the defects.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 9-11 and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Detka et al.

According to the USPTO search GenCore version 5.1.6, Detka et al. in Claim 6 (SEQ ID NO:23), discloses an amino acid sequence that is identical to the amino acid sequence disclosed in Claim 1 of the instant invention. (Claims 1, 9-11, 14-16 of the instant invention, where "x" value is 3 and 4, and "n" value is 16, 18, 28, and 36).

Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferrari et al.

According to the USPTO search GenCore version 5.1.6, Ferrari et al. disclose SEQ ID NO:48 that anticipates the second amino acid sequence disclosed in Claim 1.

Objection

Claim 1 is objected to because it lacks SEQ ID NOs.

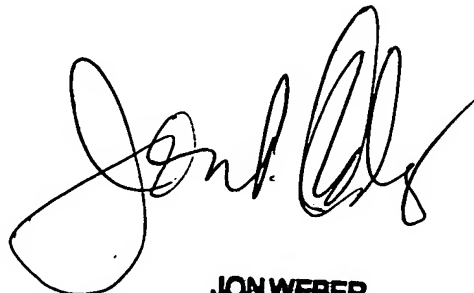
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Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Agnes Rooke whose telephone number is 571-272-2055. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

AR



JON WEBER
SUPERVISORY PATENT EXAMINER